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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
SANGAR et al.

Serial No.: 09/587,653

Filed: June 5, 2000

For: 3'SEQUENCE OF THE GB VIRUS B (GVB-B) GENOME

Group Art Unit: 1648

Examiner: Schneiner, L.

Atty. Dkt. No.: UTSG:231US

CERTIFICATE OF MAILING
37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on the date below:

December 23, 2002
Date

Charles P. Landrum

PETITION FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This is submitted in response to the decision, provided in the Final Office Action mailed on October 21, 2002, regarding a restriction requirement advanced on March 27, 2002, in the above-captioned application. The petition fee is attached. Should the fee be missing, or should any other fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 50-1212/10019302/MBW.

Applicants are petitioning the withdrawal of claims 51-55 from examination. A restriction requirement was mailed on October 3, 2001 restricting originally filed claims 1-50 into four groups. Group I, claims 1-18, 22-26 and 34-44, drawn to polynucleotide and constructs; Group II, claims 19-21 and 27-33, drawn to methods of producing virus; Group III, claims 45-47, drawn to methods for identifying a compound active against viral infection; and Group IV, claims 48-50, drawn to compounds active against viral infection. In the Response to Restriction Requirement mailed January 3, 2002 Applicants elected to prosecute, without traverse, claims 19-22 and 27-33, *i.e.*, group II. In addition to electing the claims of group II Applicants added claims 51-55, which applicants contend are within the scope of group II. Subsequently, in the Office Action mailed on March 27, 2002 the Examiner withdrew claims 51-55 as being directed to a non-elected invention.

In their response to the restriction requirement set forth in the Office Action mailed on March 27, 2002, which was upheld in the Final Office Action mailed October 21, 2002, applicants traversed the separation of claims 51-55 from Group II, drawn to methods of producing virus, *i.e.*, pending claims 19-21, 27-33 and 56, as follows:

> Claims 51-55 depend from claim 19. Claim 19 reads "A method of producing a virus comprising: introducing into a host cell a recombinant viral expression construct comprising a polynucleotide encoding a 3' sequence of GBV-B, wherein the polynucleotide comprises 50 contiguous nucleotides from SEQ ID NO:1; and culturing said host cell under conditions permitting production of virus from said construct." The claim as amended recites SEQ ID NO:1, and claims 51-55 recite SEQ ID NO:2. The Applicants note that SEQ ID NO:2 contains all of SEQ ID NO:1, as shown in the sequence listing and described on page 6 of the specification. Because claims 51-55 incorporate the limitations of claim 19, from which they depend, these claims are directed to nucleic acids whose structure is similar. Hence, no additional search would be required by the Examiner for claims 51-55 should claim 19 be found allowable, because of the overlap in sequence with independent claim 19. The Examiner and the Applicants' representative discussed in a telephone conference, which Applicants' representative appreciates, the possibility of a species election. Should the Examiner deem a species election between SEQ ID NO:1 and SEQ ID NO:2 to be

required, Applicants elect SEQ. ID. NO:1. Applicants retain the right to have a reasonable number of species examined, should the elected species be found patentable.

The examiner's rebuttal to this line of reasoning is that "... the respective structures do in fact differ and applicants' remarks are both presumptive, with respect to search burden, and incorrect since an additional search of SEQ ID NO:2 would be required. The Examiner has also determined that a species requirement is inappropriate in the instant case due to structural differences between the sequence identifiers to which the claims in question are limited."

Applicants disagree with the Examiner's reasoning and conclusion regarding the withdrawal of claims 51-55. Applicants reiterate that claims 51-55 depend from claim 19. Claim 19, as amended reads "A method of producing a virus comprising: introducing into a host cell a recombinant GBV-B viral expression construct comprising a polynucleotide encoding a 3' terminal sequence of GBV-B, wherein the polynucleotide comprises 50 contiguous nucleotides from SEQ ID NO:1; and culturing said host cell under conditions permitting production of virus from said construct." The claim as amended recites SEQ ID NO:1, and claims 51-55 recite SEQ ID NO:2, which comprises SEQ ID NO:1 and additional viral sequences. The Applicants note that SEQ ID NO:2 contains all of SEQ ID NO:1, as shown in the sequence listing and described on page 6 of the specification. Because claims 51-55 incorporate the limitations of claim 19, from which they depend, these claims are directed to nucleic acids whose structure is similar. Hence, no additional search would be required by the Examiner for claims 51-55 should claim 19 be found allowable, because of the overlap in sequence with independent claim 19.

For the Commissioner's benefit, Applicants have provided a clean copy of the claims as amended in Response to the Final Office Action mailed October 21, 2002 (Appendix A).

Therefore, applicants respectfully petition the Commissioner to overturn the restriction of claims 51-55. Should any questions regarding this paper arise, the interested party should contact the undersigned at 512-536-5674.

Respectfully submitted,

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APPENDIX A – CLEAN COPY OF CLAIMS AS AMENDED IN RESPONSE TO FINAL OFFICE ACTION

19. (Twice amended) A method of producing a virus comprising:

introducing into a host cell a recombinant GBV-B viral expression construct comprising a polynucleotide encoding a 3' terminal sequence of GBV-B, wherein the polynucleotide comprises 50 contiguous nucleotides from SEQ ID NO:1; and

culturing said host cell under conditions permitting production of a virus from said construct.

20. The method of claim 19, wherein said polynucleotide comprises 100 contiguous nucleotides from SEQ ID NO:1.

21. The method of claim 20, wherein said polynucleotide comprises SEQ ID NO:1.

27. The method of claim 19, wherein said host cell is a prokaryotic cell.

28. The method of claim 19, wherein said host cell is a eukaryotic cell.

29. The method of claim 28, wherein said host cell is in an animal.

30. The method of claim 19, wherein said polynucleotide comprises recombinant RNA.

31. The method of claim 19, wherein said polynucleotide comprises recombinant DNA.

32. The method of claim 19, further comprising the step of isolating virus from said host cell.

33. The method of claim 32, wherein said virus is purified to homogeneity.

51. (Withdrawn) The method of claim 19, wherein said polynucleotide comprises at least 250 contiguous nucleotides of SEQ ID NO:2.

52. (Withdrawn) The method of claim 19, wherein said polynucleotide comprises at least 500 contiguous nucleotides of SEQ ID NO:2.

53. (Withdrawn) The method of claim 19, wherein said polynucleotide comprises at least 1000 contiguous nucleotides of SEQ ID NO:2.

54. (Withdrawn) The method of claim 19, wherein said polynucleotide comprises at least 5000 contiguous nucleotides of SEQ ID NO:2.

55. (Withdrawn) The method of claim 19, wherein said polynucleotide comprises SEQ ID NO:2.

56. (Amended) A method of producing a GBV-B or chimeric GBV-B virus comprising:

obtaining a virus produced by the method of claim 19;

introducing the virus into a second host cell; and

culturing said host cell under conditions permitting production of virus.